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OFFICE OF PETITIONS

In re Patent of Krebs et al. : DECISION ON REQUEST
Patent No. 7,574,246 : FOR RECONSIDERATION OF
Issue Date: August 11, 2009 : PATENT TERM ADJUSTMENT
Application No. 10/520,270 : AND NOTICE OF INTENT TO
Filing Date: August 5, 2005 : ISSUE CERTIFICATE OF
Attorney Docket No. 18661-0002US1 : CORRECTION

This is a decision on the petition filed October 9, 2009, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate that the term of the patent is extended or adjusted by two hundred seventy-three (273) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two hundred seventy-three (273) days is **GRANTED to the extent indicated herein**.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

Issue 1

Patentees contend the period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 199 days. Pursuant to 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include any time period consumed by continued examination. Although Patentees recognized the need to exclude a time period due to the RCE, Patentees failed to exclude the actual date the RCE was filed from the period of B Delay. B Delay in this case is 198 days, not 199 days, after the date the RCE was filed is excluded from the period of B Delay.

The period of B Delay and the period of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") do not overlap. Therefore, the patent term adjustment should have included an increase of 198 days for B Delay.

Issue 2

Patentees object to the Office's entry of a reduction under 37 C.F.R. § 1.704(c)(10).

The Office issued a Notice of Allowance on April 1, 2009.

On June 30, 2009, applicants filed a two-page issue fee transmittal letter and a copy of a completed issue fee transmittal form (PTOL-85b). The letter was titled "Response to Notice of Allowance" and stated,

In response to the Notice of Allowance mailed April 1, 2009, enclosed is a completed issue fee transmittal form.

The required issue and publication fee in the amount of \$1810 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 18661-0002US1.

As a result of the June 30, 2009 correspondence, the Office entered a 43-day reduction under 37 C.F.R. § 1.704(c)(10).

A review of the "Response to Notice of Allowance" indicates the Office's entry of a 43-day reduction under 37 C.F.R. § 1.704(c)(10) was improper.

Issue 3

As part of Patentees' duty of good faith and candor, Patentees note the Office should have entered a reduction of 37 days for the Information Disclosure Statement ("IDS") filed January 29, 2009.

The Office mailed a non-final Office action on August 21, 2008. Patentees filed a reply on December 22, 2008, followed by an IDS on January 28, 2009.

The record fails to indicate the IDS was expressly requested by the examiner and the IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d). Therefore, the Office agrees the Office should have entered a 37-day reduction under 37 C.F.R. § 1.704(c)(8) as a result of the IDS filed January 28, 2009.

Conclusion

The period of A Delay is 260 days.

The period of B Delay is 198 days.

The period of overlap between A and B Delay is 0 days.

The patent term adjustment on the patent was based on a period of delay under 37 C.F.R. § 1.704 (“Applicant Delay”) of 192 days. However, once the improper 43-day reduction is removed and the proper 37-day reduction entered, Applicant Delay is 186 days.

A Certificate of Correction will be issued indicating a patent term adjustment of 272 days which is the sum of 260 days of A Delay and 198 days of B Delay reduced by 0 days of overlap and reduced by 186 days of Applicant Delay.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **two hundred seventy-two (272) days**.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,574,246 B2
ISSUE DATE : August 11, 2009
INVENTOR(S) : Krebs et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 68 days.

Delete the phrase "by 68 days" and insert - by 272 days--